

*REMARKS*

Reconsideration of the referenced application is respectfully requested in view of the foregoing amendments and the following remarks.

*Status of the Application*

Claims 37-76 are currently under examination. Upon entry of the amendments in this response, claims 1-36, 38-42, 48, 54, 55 and 62-72 are cancelled without prejudice, claims 37, 43-47, 58-61 and 75 are amended, and claims 77-80 are newly presented. As these amendments are fully supported by the application as filed, no new matter has been introduced into the application by way of these amendments.

*Summary of the Office Action*

Claims 37-42, 47-48, 56-61 and 72-76 and are rejected under 35 U.S.C. § 103(a) as being unpatentable over Garratt et al. [Garratt, Peter J., *Mapping the Melatonin Receptor. 3. Design and Synthesis of Melatonin Agonists and Antagonists Derived from 2-Phenyltryptamines*, Journal of Medicinal Chemistry, 38(7) (1995), 1132-1139] in view of Patani et al. [Patani, George A., Bioisosterism: A rational approach in drug design. *Chem. Rev.* 96 (1996) 3147-3176].

Claims 37-40, 47-48, 56-61 and 72-76 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. [Chen, Jia Jun, *Synthesis of 2-Iodo and 2-Phenyl-[<sup>3</sup>H]melatonin: Potential PET Tracers for Melatonin Binding Sites*, Applied Radiation and Isotopes, 49(12) (1998), 1573-1579] in view of Patani et al. [Patani, George A., Bioisosterism: A rational approach in drug design. *Chem. Rev.* 96 (1996) 3147-3176].

Claims 37-42, 47-48, 56-61 and 72-76 and are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spadoni et al. [Spadoni, Gilberto, *2-Substituted 5-Methoxy-N-*

*acyltryptamines: Synthesis, Binding Affinity for the Melatonin Receptor, and Evaluation of the Biological Activity*, Journal of Medicinal Chemistry, 36, (1993), 4069-4074] in view of Patani et al. [Patani, George A., Bioisosterism: A rational approach in drug design. *Chem. Rev.* 96 (1996) 3147-3176].

Claims 37-40, 47-48, 56-61 and 72-76 and are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sastre et al. [Sastre, J.A. Lopez, *Biological activity of melatonin and some analogous: geometrical and electrical requirements*, Journal of Molecular Structure (Thermochem) 53, (2001), 271-281] in view of Patani et al. [Patani, George A., Bioisosterism: A rational approach in drug design. *Chem. Rev.* 96 (1996) 3147-3176].

Claims 37-40, 47-48, 56-61 and 72-76 and are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivara et al. [Rivara, Silvia, *Three-Dimensional Quantitative Structure— Activity Relationship Studies on Selected MT<sub>1</sub> and MT<sub>2</sub> Melatonin Receptor Ligands: Requirements for Subtype Selectivity and Intrinsic Activity Modulation*, Journal of Medicinal Chemistry, 46 (2003) 1429-1439] in view of Patani et al. [Patani, George A., Bioisosterism: A rational approach in drug design. *Chem. Rev.* 96 (1996) 3147-3176].

Claims 37-40, 47-48, 56-61 and 72-76 and are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mor et al. [Mor, Marco, *Synthesis, Pharmacological Characterization and QSAR Studies on 2-Substituted Indole Melatonin Receptor Ligands*, Bioorganic and Medicinal Chemistry, 9 (2001) 1045-1057] in view of Patani et al. [Patani, George A., Bioisosterism: A rational approach in drug design. *Chem. Rev.* 96 (1996) 3147-3176].

Claims 37-40, 47-48, 56-61 and 72-76 and are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. [Ito, Satoru, *Acetone-Sensitized Photocoupling of 5-Bromouridine to Tryptophan Derivatives via Electron-Transfer Process*, Journal of American

Chemical Society, 102 (1980) 7535-754] in view of Patani et al. [Patani, George A., Bioisosterism: A rational approach in drug design. *Chem. Rev.* 96 (1996) 3147-3176].

Claims 43-46 and 49-53 are objected to for depending on a rejected base claim, but would be allowable if rewritten to incorporate the subject matter of the base claim and any intervening claims.

*Discussion of the Objection and Rejections Under 35 U.S.C. § 103(b)*

While Applicants disagree with the rejections entered under 35 U.S.C. § 103(b), Applicants have amended the claims to include allowable subject matter in order to advance prosecution and place the application in condition for allowance, cancelled claims that were not allowed, and introduced new claims which incorporate allowable subject matter therein. In view of these amendments, Applicants respectfully submit that the rejections and objections entered in the Office Action have been overcome.

*Conclusion*

Applicants respectfully submit that the pending application is in condition for allowance. If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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